



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,803	02/19/2002	Christopher J. Bonin	010124-0288	7140
26371	7590	10/04/2006	EXAMINER	
FOLEY & LARDNER LLP 777 EAST WISCONSIN AVENUE MILWAUKEE, WI 53202-5306			GOTTSCHALK, MARTIN A	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/078,803	BONIN ET AL.	
	Examiner	Art Unit	
	Martin A. Gottschalk	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 February 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-30 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02/19/2002</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. Claims 1-30 have been examined.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1, 2, and 4-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenner et al (US Pat# 5,956,716, hereinafter Kenner) in view of Carlile (US Pat# 2002/0016967).

- A. As per claim 1, Kenner discloses a method of facilitating a consumer selection of a primary care physician (Kenner: col 19, Ins 56-62), the method comprising:

selecting participating primary care physicians (Kenner: col 19, Ins 56-62);

videotaping each physician (Kenner: col 27, In 64 to col 28, In 7);

editing each videotape performance for length of time and content (Kenner: col 6, Ins 1-6; col 31, In 65 to col 32, In 5);

combining each videotape performance with at least one of a selected ancillary clinic information and a provider information to form a video visit videotape (Kenner: col 19, Ins 56-62);

developing advertising content and advertising medium describing the video visit videotape availability (Kenner: col 19, Ins 6-38 and 56-62);

collecting and processing a consumer request for the video visit videotape in response to the advertising (Kenner: col 16, Ins 12-61);

and,

providing the video visit videotape to a consumer to fill the consumer request (Kenner: col 16, Ins 12-61; col 19, Ins 56-62).

Kenner fails to disclose

preparing each physician for a videotape performance;

however this feature is well known in the art as evidenced by the teachings of Carlile (Carlile: [0050]-[0051], i.e. the sales rep is getting the physician up to speed on the product in anticipation of the videotape performance which will prompt a patient to ask questions about the product.).

It would have been obvious at the time of the invention to one of ordinary skill in the art to include the teachings of Carlile within the system of Kenner with the motivation of providing authoritative information to patients seeking to improve their chances of recovering from their disease.

B. As per claim 2, Kenner discloses the method of claim 1, including the step of

reporting the relationship between the consumer request and the physician selected by the consumer (Kenner: col 4, Ins 54-59; col 12, Ins 56-64; col 32, Ins 37-50).

C. As per claim 4, Kenner discloses the method of claim 1, including the step of

combining selected physicians for the video visit videotape based on geographic location (Kenner: col 11, Ins 4-7; col 14, Ins 29-43; col 18, Ins 54-65; col 28, Ins 7-12.).

E. Claims 5-30 are rejected for substantially the same reasons as provided for claims 1, 2, and 4.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kenner in view of Carlile as applied to claim 2 above, and further in view of Shapira et al (US Pat# 6,925,442, hereinafter Shapira).

A. As per claim 3, Kenner discloses the method of claim 2, including the step of reconciling the consumer request with the physician selected by the consumer (Kenner: col 16, Ins 39-44, the Examiner considers the user selecting specific records, i.e. videos, from a larger list based on the user's query, to be a type of reconciliation of the user's request with the selection, and that the video selection represent physicians about which the user wishes to obtain information.).

Kenner and Carlile fail to disclose

determining a return on investment based on at least

a cost to produce the video visit videotape

and

a cost charged to the consumer by the physician selected by the consumer,

However, these features are well known in the art as evidenced by the teachings of Shapira who teaches measuring the return on investment of an Internet advertising campaign (Shapira: col 10, Ins 45-49, Tables 7 and 8, cost to produce reads on “cost of campaign” and cost charged to the consumer reads on “visitor value”).

It would have obvious at the time of the invention to one of ordinary skill in the art to combine the disclosures of Shapira within the teachings of Kenner and Carlile with the motivation of measuring the effectiveness of an Internet advertising campaign (Shapira: col 1, Ins 58 to col 2, Ins 16), which can comprise a plurality of media including video (Shapira: col 1, Ins 9-16).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art discloses systems and

methods for health service procurement; and video and advertising production and distribution.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Thurs 8:30 -6 and alternate Fri 8:30 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MG
07/30/2006


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER

Application/Control Number: 10/078,803
Art Unit: 3626

Page 8